

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EIJI MURAMATSU, AKIYOSHI INOUE,
SHOJI TANIGUCHI, HIROYUKI TAKAHASHI,
SHIGENORI MURAKAMI, and
TOSHIHIKO TAKISHITA

Appeal No. 96-1849
Application 08/298,773¹

ON BRIEF

Before THOMAS, JERRY SMITH, and FLEMING, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-8, which constitute all the claims in the application.

The disclosed invention pertains to a recordable optical disc suitable for recording signals according to the Compact Disc Video (CDV) format. The specification notes that the normal recording of CDV signals on a Recordable Compact Disc (CD-R) permits the wobble frequency in the video recording area to interfere with the frequency band of an EFM modulated digital signal. The invention eliminates this problem by placing guide grooves in the audio and video recording areas which have a wobble frequency which will not interfere with a frequency band of an EFM signal.

Representative claim 1 is reproduced as follows:

1. A recordable optical disc on which information is recorded by applying a light beam on the surface thereof, comprising:

a first recording area on which information is recorded and reproduced while the disc is rotated at a first linear velocity; and

a second recording area on which information is recorded and reproduced while the disc is rotated at a second linear velocity, each of the first recording area and the second recording area comprising guide grooves having a wobble frequency free from interference with a frequency band of an EFM signal.

The examiner relies on the following reference:

The admitted prior art as shown in Figures 2A and 2B of the application.

Claims 1-8 stand rejected under 35 U.S.C. § 102(b) as being clearly anticipated by the admitted prior art of Figures 2A and 2B.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of anticipation relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments

in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the disclosure of the admitted prior art does not fully meet the recitations of claims 1-8. Accordingly, we reverse.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

With respect to independent claims 1 and 5, the examiner notes that Figure 2B shows that the wobble frequency in the second area of a disc recorded in CDV format has a value of 179.55 kHz. The examiner observes that since the frequency band of EFM signals is 196-720 kHz, there is no interference between this frequency band and the wobble

frequency shown in Figure 2B [answer, page 3].

Appellants respond that the examiner is incorrect because the wobble frequency of Figure 2B interferes with the EFM frequency band because (1) the wobble signal produces second harmonics which may interfere with the EFM signal, and (2) the component of the wobble frequency has a bandwidth of +/- 50 kHz [brief, page 4]. The examiner basically questions the accuracy of the statements made by appellants in support of their position [answer, pages 4-5]. Appellants respond that their assertions represent properties of signals which would be clearly recognized by the person skilled in this art [reply brief].

We agree with appellants' position for the same reasons advanced by them as amplified by the following comments. If the examiner is going to rely on prior art as admitted by an applicant for a rejection on anticipation, he must accept the prior art exactly as offered by the applicant. The admitted prior art relied on by the examiner includes the corresponding description of this prior art in the specification. The specification describes the wobble frequency of the second area as being 180 kHz which "means

that the signal to be recorded interferes with the frequency band of EFM signal (196-720 kHz), and therefore it is impossible to record digital signal in the second area" [specification, pages 5-6]. The examiner cannot accept this prior art for use in a rejection and assert at the same time that the prior art has properties different from the very properties described in the prior art. The admitted prior art describes an interference which is contrary to the recitations of independent claims 1 and 5, and the examiner cannot apply such admitted prior art under 35 U.S.C. § 102 in a manner inconsistent with its own disclosure.

Since the admitted prior art does not anticipate the invention of independent claims 1 and 5, such art does not anticipate the invention as recited in any of the claims on appeal. Therefore, the decision of the examiner rejecting claims 1-8 under 35 U.S.C. § 102 is reversed.

REVERSED

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JAMES D. THOMAS)	
Administrative Patent Judge)	
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JERRY SMITH)	
Administrative Patent Judge)	APPEALS AND
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MICHAEL R. FLEMING)	
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